

### **Remarks**

This Amendment is submitted in response to the Office Action mailed on June 10, 2003. Claims 1-13, 16 and 17 are pending and claims 1, 2, 7 and 11 are amended. In view of the foregoing amendments, as well as the following remarks, Applicant respectfully submits that this application is in complete condition for allowance and requests reconsideration of the application in this regard.

### **Objections to the Claims**

Claim 7 stands objected to because of an informality. Applicant has amended claim 7 to address the specific informality noted by the Examiner and, therefore, requests that the objection be withdrawn.

### **Rejections of Claims Under 35 U.S.C. § 112**

Claims 11, 13 and 17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant has clarified in line 4 that the "blank" is stamped. However, Applicant respectfully disagrees that the use of "the article" in line 5 is indefinite as the term "an article" is introduced in the preamble of claim 11 and, clearly, the reference in line 5 refers back to the same "article." Applicant respectfully requests that the rejections be withdrawn.

### **Rejections of Claims Under 35 U.S.C. § 103(a)**

Claims 1-10 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,989,631 (Dorfschmidt) in view of U.S. Patent No. 5,411,014 (Paul) and Meyer Aluminum Unlimited (© 2000) [pages 1 and 2]. The Examiner asserts that Dorfschmidt discloses a procedure that entails applying a cover layer to an exterior of a cookware article, anodizing the article after the cover layer is applied, and then applying a non-stick material to the anodized interior. The Examiner asserts that Paul discloses applying an enamel coating to the exterior of a cookware article. Finally, the Examiner asserts that Meyer Aluminum Limited teaches hard anodizing aluminum. The Examiner contends that the invention would have been obvious because one skilled in the art would have been motivated to repeat the applying step to provide a second porcelain enamel coating over the first porcelain enamel coating as a duplication of steps. Applicant respectfully disagrees for the reasons set forth below.

Claim 1 recites applying a first porcelain enamel coating to the exterior of the article, then exposing the interior and exterior of the article to an anodizing acid solution to hard anodize the interior of the article, and finally applying a second porcelain enamel coating over the first porcelain enamel coating after the hard anodizing step. The entire article (interior and exterior) is exposed to an anodizing acid solution after the first enamel coating is applied to the exterior, which anodizes the interior of the cookware article. However, due to the presence of the first porcelain enamel coating, the exterior is not hard anodized as the underlying metal is covered and protected by the first porcelain enamel coating. However, exposure to the

anodizing acid solution severely degrades the first porcelain enamel coating. A second porcelain enamel coating is then applied to the degraded first porcelain enamel coating on the exterior of the article.

Applicant's claim 1 recites a series of process steps which, when carried out in the claimed order, apply two coatings of the same material, namely porcelain enamel, to the exterior of a cookware article for forming an article having a hard anodized interior and a porcelain enamel-coated exterior. The first porcelain enamel coating serves as a partially sacrificial material that is severely degraded by exposure to the anodizing acid solution. The degraded first porcelain enamel coating is then used as a base for application of the second porcelain enamel coating. Absent the presence of the first porcelain enamel coating, the exterior of the cookware article would be anodized by exposure to the anodizing acid solution and the second porcelain enamel coating could not successfully adhere to the exterior. Applicant's claimed invention overcomes the conventional difficulties associated with applying a porcelain enamel coating to an anodized surface.

The Examiner appears to be applying a *per se* rule that the duplication of parts has no patentable significance, which is legally incorrect. In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Applicant submits that the Examiner has not carried out the required fact specific analysis. That is, the Examiner has not explained why Dorfschmidt shows that one of ordinary skill in the art would have been led to duplicate portions of Dorfschmidt to make a cookware article by the method recited in the Applicant's claimed invention, and would have had a reasonable expectation of success in doing so. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d

1673, 1680 (Fed. Cir. 1988). The Examiner has not directed the Applicant to any teaching or suggestion in Dorfschmidt or other prior art for duplication of any portion(s) of the disclosed method. Instead, it appears the Examiner has reached this conclusion based upon impermissible hindsight derived from Applicant's own disclosure.

When one does perform the required fact specific analysis, it becomes clear that the prior art actually teaches away from the claimed invention. Dorfschmidt provides a structure that is "acid-resistant." See Dorfschmidt at column 2, lines 37-48. Dorfschmidt does not contemplate the necessity of applying a second enamel coating. Instead, Dorfschmidt's sole enamel coating is present during the anodizing process because the enamel is specifically formulated to withstand exposure to the anodizing acid solution. It follows that Dorfschmidt does not and could not provide a suggestion for a second coating step after the anodizing step. In contrast, Dorfschmidt actually teaches away from Applicant's claimed invention.

As to the Examiner's contention that "it is well within the skill of the art to apply a second coating for the purpose of improving wear resistance, scratch resistance, corrosion resistance or thermal conductivity," Applicant submits that a conclusory statement such as this is insufficient as a rationale to support *prima facie* obviousness. In ascertaining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The mere fact that references are capable of being combined or modified as suggested by the

Examiner does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The Examiner's statement that applying a second enamel coating would have been "well within the skill of the art" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); Al-Site Corp. v. VSI Int 'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). In this case, there is no evidence that a second coating step would have provided any additional benefit to the Dorfschmidt cookware article, including any further enhancement of the properties mentioned by the Examiner. This statement by the Examiner is not based on evidence found in the prior art but is merely conjecture.

For at least these reasons, Applicant submits that claim 1, and claims 2-10 and 16 depending therefrom, are allowable and that the rejection of these claims should be withdrawn. Furthermore, claims 2-10 and 16 recite unique combinations of elements not taught, disclosed or suggested by the combined references cited by the Examiner. For example, dependent claim 16 recites "partially removing the first coating from the exterior" of the cookware article. None of the applied references discloses, nor does any of the applied references suggest a motivation or rationale for, partially removing an enamel coating.

Claims 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dorfschmidt, Paul and Meyer Aluminum Unlimited (© 2000) further in

view of U.S. Patent No. 5,628,426 (Doyle et al.). Independent claim 11, and claim 17 depending therefrom, are allowable for as least the same reasons discussed above with respect to independent claim 1. Furthermore, claims 11 and 17 recite unique combinations of elements not taught, disclosed or suggested by the combined references cited by the Examiner.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dorfschmidt in view of Paul. Applicant respectfully disagrees. Neither Dorfschmidt nor Paul discloses two porcelain enamel coatings applied to an anodized cookware article. More specifically, neither reference recognizes a coating structure on the article's exterior that includes a first enamel coating that has been subjected to anodizing and a second enamel coating overlying the first enamel coating. Although the first enamel coating is severely degraded by the anodizing acid solution, it nevertheless supplies a viable base for the overlying second enamel coating. This specific coating structure is not disclosed, taught or suggested by either reference.

### **Conclusion**

Applicant has made a bona fide effort to respond to each and every requirement set forth in the Office Action. In view of the foregoing amendments and remarks, this application is submitted to be in complete condition for allowance and, accordingly, a timely notice of allowance to this effect is earnestly solicited. If there is any additional matter that may be resolved by telephone or fax, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicant does not believe that any fees are due in connection with this submission other than the three month extension fee. However, if such petition is due or any other fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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